

DEC 06 2006 Attorney Docket No.: 1033-A00498-C1

REMARKS

The Office Action dated September 22, 2006 (the "Office Action") stated that claims 31-33 and 36-40 were rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0182052 ("DeLorme") in view of U.S. Pat. App. Pub. No. 2006/0116507 ("Oppermann"). *Office Action*, p. 5. Applicants respectfully submit that this rejection is improper, apparently as a result of a computer error within the Patent and Trademark Office.

In particular, if a search for Publication No. 2006/0116507 is conducted using the Patent Application Full Text and Image Database (the "Patent Database"), a patent application entitled "Osteogenic Devices" by applicants Hermann Oppermann et al. is presented as the sole search result. The Oppermann application from the Patent Database purports to have the publication number 2006/0116507. The application serial number of the Oppermann application is 08/957,425, and its filing date is October 24, 1997.

However, if a search for Publication No. 2006/0116507 is conducted in the Patent Application Information Retrieval (PAIR) system, the sole search result is a patent application entitled "Method and System for Provisioning a Wireless Device" to Yue Chen et al. filed November 30, 2004. The "Image File Wrapper" tab of the PAIR system display for the Yue Chen application demonstrates that the information associated with the Yue Chen application in PAIR is correct. There is no reference in the PAIR entry for Application No. 08/957,425, the Oppermann application, to an application dealing with wireless devices. It appears that a computer error in the Patent Database has incorrectly associated the filing information of the Oppermann application with the Yue Chen application. Thus, the Yue Chen application appears to be the source of the disclosure cited in the Office Action. The Yue Chen application was not filed until November 30, 2004, and therefore, is not prior art to the present application.

The rejection of claims 31-33 and 36-40 apparently relies on Yue Chen (though calling it Oppermann) to disclose features of independent claims 31 and 38. *Office Action*, p. 6. Since Yue Chen is not prior art to claims 31 and 38, any combination relying on Yue Chen cannot be used to reject claims 31 and 38. Therefore, no *prima facie* case of obviousness has been establish with regard to claims 31 and 38, and claims 31 and 38 are allowable. Additionally,

claims 32-33, 36-37, and 39-40, which depend from one of claims 31 and 38 are also allowable. Reconsideration is respectfully requested.

The Office Action also rejected claims 18-30 under 35 USC 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0182052 ("DeLorme") in view of U.S. Pat. No. 5,903,832 ("Seppanen"). *Office Action*, p. 2. Applicants respectfully traverse these rejections.

Claim 18 recites a user zone comprising a desired area of operation to subscribe to wireless service options. The Office Action correctly acknowledges that DeLorme does not disclose or suggest a user zone comprising a desired area of operation to subscribe to wireless service options. *Office Action*, p. 3. However, the Office Action asserts that Seppanen discloses a user zone comprising a desired area of operation to subscribe to wireless service options, at column 8, lines 55-61. *Office Action*, p. 3.

Seppanen actually discloses:

If the registration attempt fails, the mobile station 10 may give an audible signal, displays the message shown in FIG. 13, and goes back to the selection list (e.g., FIGS. 6A or 7A).

Further in accordance with this invention, when selecting a network instead by using the TEMPORARY NETWORK SELECTION menu (FIG. 3C), a user is enabled to select a network by services provided by the networks, as is illustrated in FIGS. 14A-14D and FIGS. 15A-15C.

By example, in FIG. 14C the user selects the By Service option. In response, the mobile station 10 displays a list of services available from networks already in the unified list of networks. In the example shown in FIG. 14D, the services Data and Short Message Service (SMS) are displayed. By selecting Data, the user is presented with the displays shown in FIGS. 15A-15C.

Seppanen, column 8, lines 50-65 (emphasis added).

That is, Seppanen discloses selecting a network that offers a particular service for temporary use. However, Seppanen does not disclose or suggest a user zone comprising a desired area of operation to subscribe to wireless service options, as recited in claim 18.

Further, the combination of DeLorme and Seppanen is improper because there is no motivation to combine the references. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). Here, the Office Action has selectively culled portions of DeLorme and combined them with portions of Seppanen. The two references are not related or analogous. DeLorme is directed to an "Integrated Routing/Mapping Information System" whereas Seppanen is directed to a "Mobile Terminal Having Enhanced System Selection Capabilities". That is, DeLorme deals with providing mapping and routing information. *See DeLorme*, Abstract. However, Seppanen deals with enabling mobile terminals to manage, prioritize and select between available communication systems. *See Seppanen*, column 3, lines 40-44. Thus, the two address different and unrelated problems. There is no teaching or suggestion to look to the particular references, to select the particular elements selected by the Office Action, or to combine them in the way they were combined in the Office Action.

Since the asserted combination of references fails to teach or suggest each and every feature of claim 18, and the asserted combination of references is improper, no *prima facie* case of obviousness has been established with regard to claim 18. Claim 18 is therefore allowable. Additionally, claims 19-30 are allowable at least in light of their dependence from claim 18.

CONCLUSION

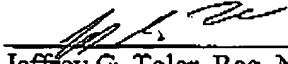
Applicants have pointed out specific features of the claims not disclosed, suggested or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections, as well as an indication of the allowability of each of the claims.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

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Date


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